



THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of:

Maurice ZAUDERER

Appl. No. 08/935,377

Filed: September 22, 1997

Art Unit: 1644

Examiner: DeCloux, Amy M.

Atty. Docket: 1821.0010000/EKS/HCC
(Formerly PENY4-628885)

For: **T Cells Specific for Target
Antigens and Vaccines Based
Thereon**

Provisional Election of Species With Traverse

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

Please note that the attorney docket number for the captioned application has changed from "PENY4-628885" to --1821.0010000--.

The Examiner has again required election of species as follows.

- (A) specific source of nucleic acid such as tumor cells;
- (B) host cells that express specific MHC molecules such as Class I;
- (C) vector of specific origin such as vaccinia vector;
- (D) specific transfer plasmid such as in claim 116; and
- (E) specific helper virus such as in claims 105 and 106.

Applicant notes that elections of (A) nucleic acids from tumor cells, (C) vaccinia virus vector, and (D) p7.5/ATG1/tk were previously made on May 1, 2000, and September 17, 2001. Thus, to be fully responsive, Applicant hereby provisionally elects, with traverse, (B) the subject matter of host cells expressing Class I MHC, as designated by the Examiner, and (E) the subject matter of fowlpox virus, as designated by the Examiner. In view of this provisional election, and the

previous elections made on May 1, 2000 and September 17, 2001, claims 68-76, 78-82, 86, 87, 89, 90, 102, 104, 105, 107-111, 117, and 119 are generic, and claims 77, 91-100, 103, 106, 112-115, 118, and 120 read on the provisionally elected species.

Applicant asserts the right to claim additional species (both in this election and in the elections made previously) in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a). This provisional election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Consideration and allowance of all pending claims are respectfully requested. Should this species election be made final, Applicants retain the right to petition from this requirement under 37 C.F.R. § 1.144.

Applicant respectfully traverses and requests the withdrawal of the requirement for election of species. As a threshold matter, Applicant points out that MPEP § 803 lists the criteria for a proper restriction requirement:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of the groups would entail a "serious burden." See M.P.E.P. § 803. In the present situation, no such showing has been made.

The Examiner has also asserted that p7.5/ATG0/tk, p7.5/ATG1/tk, p7.5/ATG2/tk, and p7.5/ATG3/tk are physically and structurally distinct. However, each transfer plasmid comprises the same promoter, and each includes unique BamHI, SmaI, PstI, and SalI sites for cloning DNA inserts. The four transfer plasmids differ *only* with respect to the placement of a translation initiation codon, either employing an endogenous translation initiation site in an insert DNA (in

vector p7.5/ATG0/tk (SEQ ID NO:6)) or by making use of a vector translation initiation site in any one of the three possible reading frames (p7.5/ATG1/tk (SEQ ID NO:7), p7.5/ATG2/tk (SEQ ID NO:8) and p7.5/ATG3/tk (SEQ ID NO:9)). Indeed, SEQ ID NOs 7-9 differ only in the addition of one (SEQ ID NO:8) or two (SEQ ID NO:9) single nucleotides following nucleotide 48 in SEQ ID NO:7, and SEQ ID NO:6 differs from SEQ ID NO:7 only in the deletion of the ATG codon at nucleotides 46-48. Since sequences p7.5/ATG0/tk, p7.5/ATG1/tk, p7.5/ATG2/tk, and p7.5/ATG3/tk are merely modifications of the same sequence, a search of each of them would largely, if not entirely, overlap. Thus, the search and examination of all of sequences p7.5/ATG0/tk, p7.5/ATG1/tk, p7.5/ATG2/tk, and p7.5/ATG3/tk would not entail a serious burden.

Applicant also notes that the Examiner is requiring an election of the members of the Markush-type claims (e.g., claim 116), and respectfully point out that MPEP § 803.02 requires that "[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits." Applicant submits that the members of the Markush groups of the pending claims are sufficiently few in number and very closely related, as they are all modifications *of the same nucleic acid sequence*, so that a search of all of the members may be made without a serious burden, contrary to the Examiner's position. Moreover, even assuming that examination of the entire claim would present a serious burden, MPEP § 803.02 states that "[f]ollowing election, the Markush-type claim will be examined fully as to the elected species and further to the extent necessary to determine patentability." If no prior art is found "that anticipates or renders obvious the elected "species," the search of the Markush-type claim *will be extended.*" *Id.* (emphasis added).

Thus, Applicant respectfully requests that the requirement for election of species be withdrawn so the restricted subject matter can be examined together.

In light of these remarks, reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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